

REMARKS/ARGUMENTS

Favorable consideration of this application is respectfully requested. Applicant has rewritten claims 1, 4-6, 9-12, 14, 19 added new claims 21-25 and canceled claims 7, 8, 13, 15, 16, and 20. Favorable reconsideration of this application is, consequently, earnestly solicited in view of the following remarks. Applicant gratefully appreciates the interview with Supervisory Examiner David Martin, and Examiner Christina Russell on November 23, 2005.

As to the objection to Fig. 1, applicant has included with this amendment response a replacement drawing sheet that indicates box 35 in Fig. 1. Removal of this objection is respectfully requested.

As to the objection to the specification, applicant has amended the specification to include the transducer reference numbers where indicated. Removal of this objection is respectfully requested.

Claim 9 was rejected under sec. 112, second paragraph as being indefinite for reciting the phrase "up to approximately." This objection is now moot since the terms "up to" have been deleted. Removal of this rejection is respectfully requested.

Claims 1, 2, 4-8, 10, 16 and 18 have been rejected to under sec. 102b as being anticipated by Ikuma '186.

Subject independent claims 1 and 10 have been amended to clarify that the invention includes rotatable knobs mounted to side faces of the pickup unit. Claims 1 and 21 require the knobs have a rotational axes being perpendicular to the axis through the top and bottom of the unit. Claims 4 and 19 claim four rotatable knobs with two knobs on one side face and the other two knobs on the opposite side face.

Claims 6, 10 and 12 have been amended to clarify the padded surface of the novel screwable clamp that mounts the pickup unit to the stringed instrument without damaging the instrument. Amended claim 11 and new claim 22 claim the novel features of locating the knobs not directly underneath the strings so that user's do not have to pass their fingers through the strings to access the knobs. New claims 23-25 claim similar novel features of the pickup unit.

The Ikuma device is structural different than the subject invention. The Ikuma device has knobs are on top of pickup making adjustment difficult because of string hindrance. The novel invention rotating knobs are easily reachable (away from strings) for volume change while playing a song.

The Ikuma device uses 2 individual pickups. The novel invention claims 3, 14-16 includes piezo, transducer and additional condenser microphone. The condenser microphone provides the only true natural tone.

The Ikuma device has one master volume control for overall control of the pickup sensors. This truly is not an output signal control but simply a balance between the sensor pickup. The novel invention pickup claims in most claims individual volume controls for the three sensors plus a genuine control for true output signal. In other words, to change the amplifier volume in performance player must adjust the actual amplifier controls on the Ikuma device. The true volume control of the novel invention allows the player to adjust overall volume on the pickup.

The Ikuma device does cause damage to the instrument by requiring a cable floating on top of the instrument which is prone to marring the finish, or being

unexpectedly stepped on which could pull the pickup out of the sound hole. Thus, removal of this rejection is respectfully requested.

The Ikuma device requires a single screw (15, Fig. 4, 115, Fig. 9 to attach the pickup unit. The subject invention claims 6, 10, 12, 23 and 24 claim a structurally more secure and stable mounting configuration of having clamping members on BOTH ends of the pickup unit each with screwable members and padding to have a more secure and stable mounting connection.

Claims 3, 9, 11-15, 17, 19 and 20 were rejected under sec. 103 as being unpatentable over Ikuma in view of LaBarbera. The LaBarbera reference does not overcome the deficiencies to LaBarbera referenced above. La Barbera has a “magnetic pickup 62 with volume control 64...” column 5, lines 45+, Fig. 3. Clearly, this unit does not have plural rotatable knobs for tuning plural sensors on a single pickup unit as claimed in the subject invention nor the other novel features referenced above. For example, there is no plural “clamp(s)” with “padded” portions that are “screwable” for attaching both ends of the single pickup unit to the sound box. Thus, removal of this rejection is requested.

The mere fact that someone in the art can rearrange parts of a reference device to meet the terms of a claim is not by itself sufficient to support a finding of obviousness. The prior art must provide a motivation or reason for someone of ordinary skill in the art, without the benefit of the inventor’s specification to make the necessary changes in the reference device. Ex parte Chicago Rawhide Mfg. Co., 223 USPQ 351, 353 (Bd. Pat. App. & Inter. 1984).

There is no teaching, nor suggestion for modifying the references of record to include all the novel features of the amended claims. Under well recognized rules of the MPEP (for example, section 706.02(j)), the teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438(Fed. Cir. 1991).

Applicant contends the references cannot be modified to incorporate the features of subject claims without utilizing Applicant's disclosure. The courts have consistently held that obviousness cannot be established by combining the teachings of the prior art to Applicant to produce the claimed invention, absent some teaching, suggestion, incentive or motivation supporting the combination. In re Bond, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990).

In view of the foregoing considerations, it is respectfully urged that claims 1-6, 9-12, 14, 17-19 and 21-25 be allowed. Such action is respectfully requested. If the Examiner believes that an interview would be helpful, the Examiner is requested to contact the attorney at the below listed number.

Respectfully Submitted;



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